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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,088	03/06/2002	Jukka Jakara	003277-031	6115

21839 7590 05/27/2004

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EXAMINER	
ALVO, MARC S	

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/018,088	JAKARA ET AL	
	Examiner	Art Unit	
	Steve Alvo	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-9 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 3-6-2002.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-7 ands 9 are rejected under 35 U.S.C. 103 (a) as being unpatentable over LINSTEN et al with or without the Admitted Prior Art (specification, page 1, lines 11-14).

LINSTEN et al teaches bleaching mechanical pulp (column 5, lines 3-19) with 1 kg/ton of pulp, preferably 3 kg/ton of pulp of peracetic acid (column 2, lines 49-55) and hydrogen peroxide (column 2, lines 40-48), at a pulp consistency of 2.5 to 40% (column 5, lines 56-59). It is noted that LINSTEN et al teaches that the process could be carried out in an optional position in the bleach process. This would include before and/or after other bleach stages, e.g. the peroxide stage of columns 5 and 6. The process of LINSTEN appears to be the same as the instant process, e.g. using the same bleaching agent, e.g. peracetic acid; under the same conditions, e.g. 1 kg/ton concentration on the same material, e.g. mechanical pulp. Obviously the results of improved opacity would have been the same. The mere recitation of a newly discovered function, e.g. improving the consistency, considered as inherently possessed by the prior art process, does not cause claims drawn thereto to distinguish over the prior art. See, In re Best, 195 USPQ 430, 433(CCPA 1977). Hence the prior art references use the same steps of e.g. using the same bleaching agent, under the same conditions, on the same material. Obviously the result of improved opacity would have been the same. If this is not obvious then the ADMITTED PRIOR ART teaches the opacity decreases when the brightness increases. Thus it is known that there is a trade-off between opacity and brightness. When high amounts of

peracetic acid are used the brightness increases and the opacity decreases. It would have been obvious to the artisan that when the low amounts of peracetic acid taught by LINSTEN et al are used that the brightness would decrease and that the opacity would increase, in comparison to when larger amounts of peracetic acid are used, as the ADMITTED PRIOR ART teaches that they are inversely proportional.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over LINSTEN et al as applied to claim 1 above, and further in view of CHANG et al.

CHANG et al teaches that peracetic acid can be formed in situ by mixing Caro's acid to acetic acid to form a mixture of Caro's and peracetic acid. CHANG et al teaches that such mixed peracetic acid solutions have improved delignification and brightening. It would have been obvious to form the peracetic acid of LINSTEN et al in situ, in the manner taught by CHANG et al, to obtain the improved delignification and brightening taught by CHANG et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Alvo whose telephone number is 571-272-1185. The examiner can normally be reached on 5:45 AM - 2:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steve Alvo
Primary Examiner
Art Unit 1731

Msa